

REMARKS/ARGUMENTS

Applicant has reviewed the Office Action dated as mailed July 28, 2006 and the documents cited therewith. After the above amendments, the application contains claims 1-4 and 6-15. Claims 1, 6, 7, 10, 11, and 13 have been amended. Claims 5 and 16-105 have been canceled.

Claim Rejections – 35 USC § 102

Claims 1, 2, and 13-15 were rejected under 35 U.S.C. §102(b) as being anticipated by JP409314362A. This rejection is respectfully traverse. Claim 1 has been amended to recite:

“a housing to enclose the energy beam transfer devices and at least a portion of the workpiece to be processed, wherein the housing includes:
a first part; and
a second part, wherein the first part and the second part are pivotably coupled from movement relative to another to releasably enclose at least the portion of workpiece to be processed.”

Applicant respectfully that submits that JP409314362A does not teach or suggest a housing to enclose the energy beam transfer devices and that the housing includes a first part and a second part wherein the first part and the second part are pivotably coupled for movement relative to one another to releasably enclose at least the portion of the workpiece to be processed as provided by the present invention as recited in amended claim 1.

U.S. Patent 4,689,467 to Inoue was cited in the rejection to the dependent claim 5 because Inoue discloses an enclosure for the beam apparatus and workpiece. Inoue teaches a cover member 503 which is bolted to a pressure reducing chamber 501, as clearly shown in

Figure 5 of Inoue and described in column 10, beginning at line 18. However, Inoue does not teach or suggest that the cover member is pivotably coupled to the chamber 501 for movement relative to one another to releaseably enclose at least a portion of the workpiece as provided by the present invention as recited in claim 1.

Therefore, claim 1 is submitted to be patentably distinguishable over the documents of record, and reconsideration and withdraw of the Section 102 rejection of claim 1 is respectfully solicited.

With regard to the rejection of claims 2 and 13-15 under 35 U.S.C. §102(b) as being anticipated by JP409314362A, these claims recite additional features which further patentably distinguish over the cited document. Additionally, these claims depend directly from independent claim 1, and by virtue of that dependency, contain all of the features of claim 1. Therefore, these claims are also submitted to be patentably distinguishable over JP409314362A, and reconsideration and withdraw of the 35 U.S.C. §102 rejection of claims 2 and 13-15 is respectfully solicited.

Claim Rejections – 35 USC § 103

Claims 3 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of U.S. Patent 4,843,209 to Milligan ("Milligan"). This rejection is respectfully traversed. Applicant respectfully submits that this rejection under 35 U.S.C. §103 does not follow the M.P.E.P. § 706.02(j) which states:

"After indicating that the rejection is under 35 U.S.C. §103, the examiner should set forth in the Office Action:...(B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification... the teaching or suggestion to make the claimed combination and the reasonable expectation of the success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

As discussed in detail below, Applicant respectfully submits that there is no teaching or suggestion in JP409314362A and Milligan that their teachings may be combined so as to provide the present invention as recited in the claims and such motivation only comes from Applicant's disclosure. This approach constitutes impermissible hindsight and must be avoided. The Abstract of JP409314362 recites:

"A laser beam b<SB>1</SB> from a laser beam oscillator of a CO<SB>2</SB> laser, etc., is made incident on a beam splitter 3 by a total reflection mirror 2 and splitted. With the splitted one side laser beam b<SB>3</SB>, a quenching surface 4A of a work 4 is irradiated, it is cooled naturally after heating, and it is quenched with transformation hardening. The other side laser beam b<SB>2</SB> is made incident on a face 4B for correcting strain of the opposite side to the quenching surface 4A through three total reflection mirrors."

Accordingly, JP409314362 teaches to direct a laser beam to an opposite side of a quenching surface of a workpiece to apply heat to the opposite side to correct strain to the quenching surface. In contrast, Milligan teaches a method and apparatus for laser staking of a haptic to an optic of an intraocular lens. Milligan in column 4, line 36 discloses:

"A laser beam 122, emitted from the fiber optic laser stylus 32, penetrates the lens optic 100 to heat both the end portion of the haptic 102 engaged in haptic hole 112 and the cylindrical surfaces of the haptic hole 112 to fuse and unite the outer cylindrical surface of the haptic 102 to the cylindrical surfaces of haptic hole 112."

Thus, the invention of Milligan is for laser staking of a haptic to an optic of an intraocular lens which involves joining delicate optical components where correcting strain due to laser

quenching is not a concern. In contrast, JP409314362 teaches using a laser to apply heat to an opposite side of a quenched surface of a workpiece to reduce strain caused by the heating of the quenched surface. Accordingly, a person of ordinary skill in the art would not be motivated to combine the teaching of JP409314362 and Milligan and such motivation can only come from Applicant's disclosure.

Even if it were proper to combine the teaching of JP409314362 with Milligan, they still would not provide the present invention as recited in the claims. Claims 3 and 12 depend either directly or indirectly from independent claim 1. Because of this dependency, claims 3 and 12 contain all of the features of claim 1. Applicant respectfully submits that Milligan adds nothing to the teachings of JP409314362 so as to render amended claim 1 unpatentable. Reconsideration and withdrawal of the Section 103 rejection of claims 3 and 12 is respectfully requested.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of Milligan as applied to claim 1 and further in view of JP408300180A and JP02000102886A. Applicant respectfully submits that only JP409314362 was applied to reject claim 1 under 35 U.S.C. §102 and Milligan was not applied to reject claim 1 in the Office Action. However, as just described, Applicant respectfully submits that the combination of JP409314362A and Milligan is improper under M.P.E.P. §706.02(j).

JP408300180A and JP02000102886A were cited for describing the use of switches. JP409314362A merely teaches applying heat to the opposite surface of a quenched surface of a workpiece. Applicant respectfully submits that there is no need to use the switches of JP408300180A and JP02000102886A with JP409314362A. Therefore, there is no motivation to combine the teaching of these documents. Even if it were proper to combine the cited documents, they still would not provide the present invention as recited in claim 4. Claim 4

depends directly from independent claim 1, and by virtue of this dependency, claim 4 contains all of the features of claim 1. Applicant respectfully submits that Milligan, JP408300180A and JP02000102886A add nothing to the teachings of JP409314362A so as to render independent claim 1 as amended unpatentable. Accordingly, Applicant respectfully submits that claim 4 is patentably distinguishable over the cited documents, and reconsideration and withdraw of the 35 U.S.C. §103(a) rejection of claim 4 is respectfully requested.

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of Milligan as applied to claim 1 and further in view of U.S. Patent 4,689,467 to Inoue. As previously discussed, Applicant respectfully submits that the combination of JP409314362A and Milligan is improper. However, even if JP409314362A, Milligan and Inoue could properly be combined they still would not provide the present invention as recited in claim 13. Claim 13 has been amended to recites "wherein the device is adapted to operate in substantially a vacuum and substantially a zero gravity environment." As previously discussed, Inoue teaches a pressure reducing chamber 501 with packing 502 and a cover member 503 to sealingly close the pressure reducing chamber 501 (see Figure 5 and column 10, lines 18 and 19 of Inoue). However, Applicant respectfully submits that the pressure reducing chamber of Inoue does not mean that the laser machining apparatus of Inoue is adapted to operate in substantially a vacuum and substantially a zero gravity environment as provided by the present invention as recited in claim 13. Additionally, claim 13 depends directly from independent claim 1, and by virtue of that dependency, claim 13 contains all of the features of claim 1. As discussed with respect to claim 1, Inoue does not teach or suggest a housing where the first part and the second part are pivotably coupled for movement relative to one another to releasably enclose at least the portion of the workpiece to be processed. Accordingly, Applicant

respectfully submits that claim 13 is patentably distinguishable over JP409314362A, Milligan and Inoue, whether considered individually or combined, and reconsideration and withdraw of the Section 103 rejection of claim 13 is respectfully solicited.

Claims 5-7 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of Milligan and in further in view of JP408300180A and JP02000102886A and further in view of Inoue. As previously discussed, Applicant respectfully submits that there is no teaching or suggestion that these documents can be combined so as to provide the present invention as recited in the claims and such motivation only comes from a reading of Applicant's disclosure. Even if it were proper to combine these documents, they still would not provide the present invention as recited in the claims. Claim 5 has been canceled and claims 6-7 and 10 depend either directly or indirectly from independent claim 1. Applicant respectfully submits that Milligan, JP408300180A, JP02000102886A and Inoue add nothing to the teachings of JP409314362A so as to render independent claim 1 unpatentable. Therefore, Applicant respectfully submits that claims 6-7 and 10 are patentably distinguishable over the cited documents, and reconsideration and withdraw of the Section 103 rejection of these claims is respectfully requested.

Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of Milligan and in view of JP408300180A and JP02000102886 and in view of Inoue as applied to claim 7 and further in view of Urech et al., U.S. Patent 5,929,765 ("Urech"). Applicant respectfully submits that there is no teaching or suggestion in these documents that their teachings can be combined so as to provide the present invention and such motivation only comes after a reading of Applicant's disclosure. Furthermore, claims 8 and 9 depend either directly or indirectly from independent claim 1. Because of this dependency,

claims 8 and 9 contain all of the features of independent claim 1. Applicant respectfully submits that the cited documents and Urech add nothing to the teachings of JP409314362A so as to render independent claim 1 unpatentable. Therefore, Applicant respectfully submits that claims 8 and 9 are also patentably distinguishable over the cited documents including Urech, and reconsideration and withdraw of 35 U.S.C. §103(a) rejection of claims 8 and 9 is respectfully solicited.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP409314362A in view of Milligan and in view of JP408300180A and JP02000102886A and in view of Inoue and further in view of Peviani, U.S. Patent 4,889,002 ("Peviani"). Claim 11 has been amended to depend directly from independent claim 1. Because of this dependency, claim 11 is submitted to contain all of the features of independent claim 1. Accordingly, even if the cited documents could properly be combined under M.P.E.P. §706.02(j) they still would not provide the present invention as recited in claim 1. Therefore, claim 11 is submitted to be patentably distinguishable over the cited documents, and reconsideration and withdraw of 35 U.S.C. §103 rejection of claim 11 is respectfully requested.

Conclusion

Applicant respectfully requests entry of this amendment under Rule 116 in that this amendment cancels claims and renders all of the remaining claims in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims at the earliest possible date are respectfully requested.

In the event that the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Appl. No.: 10/707,958
Amdt. Dated September 27, 2006
Reply to Office Action of July 28, 2006

If necessary, please charge any additional fees or credit overpayment to Deposit Account


No. 13-4365.

Respectfully submitted,

Phillip L. Fuson
(Applicant)

Date: September 27, 2006

By:


Charles L. Moore, Jr.
Registration No. 33,742
Moore & Van Allen PLLC
Attorney for Applicant
430 Davis Drive, P.O. Box 13706
Research Triangle Park, NC 27709
(919) 286-8000 (telephone)